

Response to U.S. Application No. 09/980,158
Docket No. 6208-31
Reply to the Office Action of June 28, 2005

REMARKS

Applicants respectfully request reconsideration of the above referenced application in light of the remarks that follow. Claims 1-21 are now pending in this application.

In the Office Action dated June 28, 2005 (the “*Present Office Action*”), the Examiner rejected claims 1, 3-20 under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. Patent No. 6,473,892) in view of Ferrel et al. (U.S. Patent No. 5,860,073) and in further view of Smith et al. (U.S. Patent No. 6,052,693) and in further view of Tozzoli et al. (U.S. Patent No. 6,151,588). The Examiner further rejected dependent claims 2 and 21 under 35 U.S.C. 103(a) as being unpatentable over Porter, in view of Ferrel et al., and in view of Smith et al. in further view of Tozzoli et al. as applied to claims 1 and 13, and in further in view of Atkins (U.S. Patent No. 5,875,437).

The undersigned respectfully submits that the Present Office Action does not fully address the arguments presented in the Applicants’ August 30, 2004 Response to the June 10, 2004 Office Action (the “*Applicants’ Prior Response*”), and has not fully explained why such arguments are not persuasive.

As required by MPEP 707.07(f), “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s arguments and answer the substance of it.” MPEP 707.07(f).

In the Applicants’ Prior Response, the Applicants did traverse each of the Examiner’s § 103(a) rejections. In the Present Office Action, the Examiner has repeated each of those rejections, again in light of each of the above references, with the newly added Tozzoli reference. As MPEP 707.07(f) requires, the applicants are entitled to have the Examiner address the substance of the arguments they have filed with the Examiner. In the Examiner’s Present Office Action, however, the Examiner has state simply that “Applicant’s arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) for rejection.” Present Office Action, pg. 13, ¶7. The Examiner has failed to address or answer the substance of the arguments presented in the Applicants’ Prior Response. See MPEP 707.07(f). It is respectfully submitted that this is improper because it leaves the Applicants without any

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understanding as to why the previously presented arguments were not sufficient to distinguish over the cited prior art. By merely repeating previous grounds for rejection, without providing adequate further explanation, the Present Office Action does not offer the applicants or the undersigned enough information to ascertain why claims were rejected or why arguments presented were not persuasive, as is the intent of MPEP 707.07(f).

It is respectfully requested that the Examiner withdraw the Present Office Action and issue a new Office Action fully addressing the substance of the arguments presented in the Applicants' Prior Response. Previously-presented arguments are repeated below in courier font. In the alternative, the undersigned has reviewed the June 28, 2005 Office Action and respectfully traverses all rejections for the reasons set forth herein. No new matter has been added. The undersigned respectfully requests that all pending claims, as amended, be allowed.

35 U.S.C. 103(a)

The Examiner has rejected claims 1, 3-20 under 35 U.S.C. 103(a) as being unpatentable over Porter, in view of Ferrel, and in further in view of Smith, in further view of Tozzoli. For the reasons set forth below, Applicant respectfully traverses the rejection and requests allowance of the pending claims.

In the Applicants' Prior Response, Applicants replied as follows:

Porter is directed to a document assembly system that automatically determines which documents are needed for a particular transaction, automatically determines which paragraphs should be included in each document and automatically generates the text of each document (col. 6 lines 51-60) Porter compiles source code created by programmers to create object code. The object code, contained in form objects, text object, and macro objects is interpreted as Porter produces a document. (col. 7 lines 15-25)

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According to the process Porter describes, if a particular document is unsuitable for any reason, complex programming steps must be taken to modify the document. According to Porter, in order to modify a document, a programmer must make changes to the source code for the particular document to be modified. The new source code must then be recompiled into object code before the modified object code can be executed to generate a new document and determine if the new document is suitable for a task (col. 7 lines 54-65). The process of Porter is not conducive for most bankers to assemble custom documents, since most banker are not equipped to write source code and compile it into object code.

Ferrel is directed to methods of formatting information. In particular, Ferrel is directed to the application of formatting information, such as fonts and tabs to various regions on a page (col. 3 lines 7-15) Ferrel specifically does not include any text or other information in the style sheet (col. 3 lines 15-17). In Ferrel, a user must supply all text in a document. Ferrel then describes the use of tags to indicate that a style corresponding to the tag be applied to all of the text below the tag until another subsequent tag is reached. At the subsequent tag, a style corresponding with the subsequent tag will then be applied to the text following it, and so on throughout the document.

Smith is directed to a system for facilitating flow of documents in the police force of the United Kingdom that can be used in conjunction with investigations of major crimes. Smith describes both external text extraction and internal text extraction

in order to create an index of information useful to an investigation. During the course of the indexing process, ambiguity in an extracted text is resolved with rules that include: analysis that span more words are preferred over analysis that span fewer and analysis that produce bigger single units are preferred over those producing smaller units. The indexing processes take as input Grammar Rules and Word Lists to assist in interpreting text (col. 16 lines 24-39). Grammar Rules are used in Smith to instruct a word parser how to label words and phrases recognized from an input sentence and to assist in assigning an attribute to words contained in an input text. Smith also discusses the use of common Boolean equations when testing for true or false conditions. As used in Smith, the Boolean equations are disparate from the Grammar Rules and Word Lists of Smith in the sense that Smith does not describe Grammar Rules that contain Boolean equations.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed.

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Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Thus, in order for the Examiner to establish a case of obviousness, he must (a) demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention, and (b) show a motivation to modify or combine the references. The Examiner has done neither.

As discussed above, Porter describes systems that require a programmer to access and write source code in order to change a document. In Porter the mention of "objects" refers to the source code that has been written by a programmer and then compiled (or recompiled) into object code. Porter does not describe or suggest all of the claimed limitations, either alone or in view of Ferrel or in view of Smith.

The present invention provides for a system with grammar lines that contain all of the instructions needed to create the document. Each of the grammar lines includes a condition and an instruction. Data descriptive of financial transactions is received and used to test the conditions in the grammar lines. If the condition is true, then the associated instruction is executed. The instructions either move to another grammar line, or insert an object body into the document being created.

As claimed in the amended independent claims 1 and 13, the present invention teaches a simple process for modifying a document. Documents are made up of various object bodies. If a document needs to

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be modified, a user only needs to change an appropriate object body. All grammar sequences that reference that object body will consequently be changed. Unlike Porter, the present invention does not require a programmer to write source code in order to modify a document. Additionally, unlike Porter, the present invention provides an elegant solution that does not require modified source code to be recompiled in order to effect the modification to the document. Porter simply does not describe or suggest the concepts taught by the present invention, which allow for automatic assembly of easily customizable documents.

Ferrel and Smith do not make up for Porter's shortcomings. As indicated above, Ferrel describes a text formatting method and Smith describes methods for organizing information in response to a crime investigation. Neither one describes any of the aspects just discussed in regards to Porter. Even if Ferrel or Smith did describe any of these unique aspects, the Examiner has not provided any motivation to combine Ferrel with Smith.

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts." In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not shown any of these sources in the Office Action of June 10, 2004. Although, in his rejections of claims 1, 4-20 the Examiner stated that "it would have been obvious to one with ordinary skill in the art [i.e. to combine Porter and Ferrel or Smith]," he did so without offering any

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evidentiary support for his conclusion. Such conclusory statements do not constitute the requisite evidence upon which a Section 103 rejection may rest. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Thus, the Examiner cannot base a rejection purely on what he deems would be obvious to "one with ordinary skill in the art"; rather he must offer evidentiary support for what in fact is known to skilled artisans before making a conclusion as to what would be obvious to a skilled artisan.

The Examiner again fell short of meeting the requirements of the case law by concluding, in his rejection of claims 2 and 21, that Atkins describes a confirmation of a financial transaction that includes economic terms. (Office Action of June 10, 2004, p. 12).

Atkins is directed to methods and systems for personal financial analysis, planning and management. Atkins describes a central operating account for performing various functions related to personal finance. In regards to the Examiner's suggestion that Atkins describes a financial function to verify and confirm transactions, Atkins merely describes verification of a customer prior to a transaction. Atkins also describes customer verification of a transaction prior to the transaction being approved. Column 60 lines 13-16 specifically describe one example where Atkins describes "verification of whether the transaction will be permitted or denied (emphasis added). Atkins does not suggest or describe any system for automatically generating a document descriptive of one or more transactions conducted by a financial trading system, as claimed in the amended claims.

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Further, Atkins' mere mention of a Word Processing function is not sufficient to hold obvious an automated document assembly invention, simply because the Word Processor inherently could conceivably be used to generate a document describing a financial transaction. "[I]nherency . . . and [] obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." In re Spormann, 363 F.2d 444, 448 (C.C.P.A. 1966). Accordingly, the Examiner's Section 103 rejection cannot stand based on his plain statements of what is inherent in Porter and Smith or Atkins.

Applicants' Prior Response, pp. 8-11.

A review of the foregoing shows that the Office has failed to address at least the following arguments raised in the foregoing text quoted from Applicants' Prior Response:

1. Porter does not describe or suggest the concepts taught by the present invention, which allow for automatic assembly of easily customizable documents. Ferrel, which describes a text formatting method, and Smith, which describes methods for organizing information in response to a crime investigation, do not make up for Porter's shortcomings.
2. Even if Ferrel or Smith did describe any of the unique aspects of the present invention, the Examiner has not provided any motivation to combine Ferrel with Smith. The Examiner's basis for modifying Porter, that "it would have been obvious to one having ordinary skill in the art at the time the invention was made[,] is a conclusory statement not constituting requisite evidence upon which a section 103 rejection may rest, and thus insufficient to support a § 103 obviousness rejection without evidentiary support.

3. Atkins does not suggest or describe any system for automatically generating a document descriptive of one or more transactions conducted by a financial trading system, as claimed in the amended claims, and thus cannot support a § 103 obviousness rejection.
4. The Examiner's § 103 rejection cannot stand based on his plain statements of what is inherent in Porter and Smith or Atkins, because, as described above, Atkins' mention of a Word Processing function is not sufficient to hold obvious an automated document assembly invention.

The previously-raised issues are significant and need to be clearly addressed to enable the undersigned to determine what, if any, modifications are needed to the claims and to enable the undersigned to determine whether, and what, additional explanation should be provided to the Examiner to more fully explain the distinctions of the present application and Porter, Ferrel, Smith and Atkins.

Applicant respectfully traverses the Examiner's rejections in light of Porter and others and requests that the Examiner withdraw such rejection or in the alternative issue a replacement Office Action that addresses each of Applicant's arguments in accordance with MPEP 707.07(f).

With respect to independent claim 1, the Examiner has acknowledged in the Present Office Action that "Porter does not mention *a transaction file comprising a plurality of terms comprising data descriptive of one or more financial transactions performed by a trading system.*" Present Office Action, pg. 3 (emphasis in original; see claim 1). The Examiner then asserts, however, that "Tozzoli mentions a trading system that is used for financial transactions," citing to Porter at col. 4, line 53 through col. 7, line 65. Present Office Action, pg. 3. The undersigned has assumed that the Examiner intended his citation to be to the Tozzoli reference at the cited lines, but will appreciate the Examiner's clarification of this error. Notwithstanding the incorrect citation, the Examiner concludes, apparently solely on the basis of his assertion that "Tozzoli mentions a trading system that is used for financial transactions," that "[i]t would have

been obvious for one of ordinary skill in the art to apply Tozzoli to Porter, providing Porter the benefit of having a financial trading systems [sic], which would assist a user in trading strategies.” As described below, the Examiner has not demonstrated that Tozzoli overcomes Porter’s lacking with respect to the claim limitation quoted above.

The Examiner asserts that “Tozzoli mentions a trading system that is used for financial transactions” and that “[i]t would have been obvious for one of ordinary skill in the art to apply Tozzoli to Porter, providing Porter the benefit of having a financial trading systems [sic], which would assist a user in trading strategies.” Present Office Action, pp. 3-4.

Applicants respectfully submit that the Examiner has not established a case for obviousness for at least the following reasons: (1) he has failed to show a teaching or suggestion of all of the claimed limitations, (2) he has not demonstrated a motivation to modify the references’ teachings, and (3) he has assumed obviousness incorrectly and without the requisite concrete evidence, objective teaching, and factual findings or statements and explanation.

To establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. *First*, there must be some teaching, suggestion, incentive or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to combine the references and make the modifications proposed by the Examiner. *See, e.g., In re Fritch*, 972 F.2d 1260, 1265 (Fed.Cir.1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); MPEP § 2143. *Second*, there must be a reasonable expectation of success. *Finally*, the prior art reference must teach or suggest all the claim limitations. Even if a combination is proper, *all* of the limitations recited in the claim must be taught or suggested by the prior art. If even a single limitation is absent, the rejection is improper. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974); *see generally* MPEP § 2143.03.

Even if Porter, Ferrel, Smith and Tozzoli included a description of each of the claimed limitations, which they clearly do not, Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine the cited references. The Examiner has not

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demonstrated in the Present Office Action, nor in the Office Action dated June 10, 2004, a source for a motivation to combine the references. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts.”).

The grounds offered by the Examiner for combining Porter and Tozzoli is that “[i]t would have been obvious to one of ordinary skill in the art the apply Tozzoli to Porter . . .” Present Office Action, pg. 3-4. The Examiner has not made any attempt to support this conclusory statement with any evidence. The Examiner’s statement concerning “one with ordinary skill in the art” simply is not substantiated and does not meet the Examiner’s obligation to succinctly establish a *prima facie* case of obviousness. Moreover, the Examiner has not provided support for his statement.

Moreover, it is respectfully suggested that, even if Tozzoli was applied, the Examiner has not demonstrated that Tozzoli in any way includes information that teaches or discloses how to make and use the invention of the cited claim limitation, “a transaction file comprising a plurality of terms comprising data descriptive of one or more financial transactions performed by a trading system.” The Examiner merely asserts that to have done so would provide “Porter the benefit of having a financial trading systems [sic], which would assist a user in trading strategies.” Such assertion is wholly unsupported, and in the Present Office Action the Examiner does not even suggest that to have combined the teaching of Tozzoli to Porter would have taught one of ordinary skill in the art the limitation of claim 1 of the present invention, quoted by the Examiner, specifically “a transaction file comprising a plurality of terms comprising data descriptive of one or more financial transactions performed by a trading system”.

Thus, the Present Office Action fails to demonstrate that the references, including Tozzoli, include all of the limitations of the present invention, and therefore cannot be the basis of an obviousness rejection as cited. The Examiner’s reliance on Tozzoli is misplaced and ignores the fundamental inventive elements of the claimed invention.

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The undersigned therefore respectfully requests that the Examiner either withdraw his rejection of the claims or provide some objective evidence that a teaching of all of the claim limitations is found in the prior art.

With respect to independent claim 12, the Examiner has repeated the basis for his rejection from the June 10, 2005 Office Action without any modification. Specifically, the Examiner has not referenced Tozzoli in his rejection of independent claim 12. Moreover, as described above, the Examiner has not responded to the arguments presented by the Applicants in the Applicants' Prior Response, but rather has dismissed them out of hand as "moot." The undersigned respectfully submits that the Examiner has not properly addressed the Applicants' Prior Response in this regard and Applicants respectfully traverse the Examiner's rejections in light of Porter and others and requests that the Examiner withdraw such rejection or in the alternative issue a replacement Office Action that addresses each of Applicant's arguments in accordance with MPEP 707.07(f).

With respect to claims 2 and 21, the Examiner has suggested in paragraph 6 of the Present Office Action that these claims now are rejected "in further view of Tozzoli et al. as applied to claims 1 and 13." Here again, the Examiner has not addressed Applicants prior argument, specifically that "it would not have been obvious to combine Porter with Atkins and that even if Porter and Atkins were combined, their sum product would not contain the unique limitations of claims 2 and 21." Applicants' Prior Response, pg. 12. For at least the reasons stated above, Applicants hereby traverse the Examiner's rejection of these claims.

Claims 2-12 depend from independent claim 1, and claims 14-21 depend from independent claim 13, and define further features and structure of the methods and systems. As such, these dependent claims are patentable for the reasons noted above with respect to claims 1 and 13, as well as for the additional features recited therein. Accordingly, notice to the effect that claims 1-21 are in condition for immediate allowance is respectfully requested.

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CONCLUSION

For the reasons set forth above, allowance of this application is courteously urged. If there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned at (212) 878-3164 in order for the undersigned to arrange for an interview with the Examiner.

Please charge any additional fees for this Amendment or credit any overpayments to Deposit Account No. 50-0521.

Respectfully submitted,

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